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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/732,408	12/09/1996	JOHANNES REINMULLER	HUBR1099PFFM	7906

7590 12/31/2002

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/732,408

Applicant(s)

REINMULLER, JOHANNES

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 104-127 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 104-127 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 120-124, 126 are objected to because of the following informalities:

These claims depend from a cancelled claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 104, 109, 112, 116, 117 are rejected under 35 U.S.C. 102(b) as being anticipated by Ledergerber (EP 322194). Figs. 3 and 8 show “strands of material” used for an implant. Ledergerber discloses that silicone filaments or “strands” can be used in the implant, col. 9, lines 28-32. Ledergerber also discloses that foam can be used in the implant, col. 4, lines 8-18. The surface is fully capable of being “wetttable by a fluid lubricant”. It has been held that the recitation that an element is “capable of”, i.e.

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"wetable by fluid" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Ledergerber additionally discloses that an x-ray contrast medium can be incorporated into the material, col. 12, lines 53-58. Since the surface is covered with PTFE, it is inherent that it is hydrophobic, since PTFE is hydrophobic.

Claims 104-109, 114, 118, 119, 125, 127 are rejected under 35 U.S.C. 102(e) as being anticipated by Jarrett et al. (5352515). Jarrett et al. disclose a strand of material used for an implant, in the form of a suture, col. 3, lines 12-17. Jarrett also discloses that the strand or suture has a hydrophilic surface, col. 3, lines 24-27. The surface is fully capable of being "wetable by a fluid lubricant". It has been held that the recitation that an element is "capable of", i.e. "wetable by fluid" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Jarrett discloses that the implant can be a combination of hydrophobic and hydrophilic materials, col. 10, lines 42-44. Thus it can be construed the surface is hydrophobic. The material can also be a polysaccharide or a gel (col. 11, lines 19-25) that are swellable and aqueous. Sutures are inherently solid, that is not hollow.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 110,111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jarrett et al. '515 in view of Perry et al. (5282857). Jarrett is explained supra. Jarrett discloses that a low friction surface is important for a suture used in vascular surgery and that oils can be applied, col. 1, lines 29-30, col. 2, lines 37-52. Jarrett also discloses plastics for the material of the implant, col. 10, lines 5,6. However, Jarrett et al. do not disclose using fat or oil as a lubricant. Perry et al. teach that fats or oils in the form of glycerides are used in implants, col. 3, lines 1-4. It would have been obvious (step backward) to one of ordinary skill in the art to use a fat or oil that wets a surface of the implant as taught by Perry with the implant of Jarrett et in order to reduce friction in the procedure and damage to tissue.

Claim 113 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jarrett et al. '515 in view of Taylor (4657553). Jarrett et al. is explained supra. However, Jarrett does not disclose the use of polydimethylsiloxane as the implant material. Taylor teaches that polydimethylsiloxane is used in constructing medical implant material, col. 4, lines 37-44. It would have been obvious to one of ordinary skill in the art to use polydimethylsiloxane as the implant material as taught by Taylor for the implant of Jarrett because of the suitability of these materials in medical uses.

Claim 115 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jarrett et al. '515 in view of Chapman (4348329). Jarrett et al. is explained supra. However, Jarrett does not disclose cuprophane as the implant material. Chapman teaches that polymers or "plastic" used in implants have coatings that are biocompatible, col. 6, lines 32-36,49-54 and cuprophane is one material used (col. 13, lines 9,12). It would have

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been obvious to one of ordinary skill in the art to use cuprophane as an implant material as taught by Chapman for the implant of Jarrett et al. in order to reduce cell membrane damage.

Claims 120-124, 126 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jarrett et al. '515. Jarrett discloses the invention as claimed.

However, in the alternative it would have been obvious to one of ordinary skill in the art to use multiple strands of suture in a surgical procedure to repair or stitch together a large incision in the heart or other body organ.

Response to Arguments

Applicant's arguments filed 10/21/02 have been fully considered but they are not persuasive. In response to Applicant's argument that Ledergerber includes additional structure not required by Applicant's invention, it must be noted that Ledergerber discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 9am to 6:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino

TC 3700, AU 3738
December 17, 2002

Brian E. Pellegrino


CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
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